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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,791	02/01/2001	Sherry L. Neuman	ISCR00700US	2627
7590 Louis M Heidelberg Reed Smith LLP 2500 One Liberty Place Philadelphia, PA 19103-7301				
EXAMINER NAJARIAN, LENA				
ART UNIT		PAPER NUMBER		
3626				
MAIL DATE		DELIVERY MODE		
08/04/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/774,791

**Applicant(s)**

NEUMAN ET AL.

**Examiner**

LENA NAJARIAN

**Art Unit**

3626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 14, 17, 19-22, 24-31, 34, 36, 38, 42-45, 47, 49 and 89-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14, 17, 19-22, 24-31, 34, 36, 38, 42-45, 47, 49 and 89-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 6/9/08. Claims 16 and 40 have been cancelled. Claims 1-9, 14, 17, 19-22, 24-31, 34, 36, 38, 42-45, 47, 49, and 89-91 remain pending.

### ***Claim Objections***

2. The objection to claims 16 and 40 is hereby withdrawn due to the cancellation of claims 16 and 40.

### ***Claim Rejections - 35 USC § 112***

3. The rejection of claim 16 under 35 U.S.C. 112, second paragraph, is hereby withdrawn due to the cancellation of claim 16.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 9, 14, 17, 19-21, 24-27, 29-31, 34, 36, 38, 42-45, 47, 49, and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (US 6,421,650

B1) in view of Lion (US 6,330,491 B1), and further in view of Engelson et al. (US 6,671,563 B1).

(A) Claims 1-2, 9, 14, 17, 19-21, 24-27, 29-31, 34, 36, 38, 42-45, 47, 49, and 90 have not been amended and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

6. Claims 3-8, 22, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (US 6,421,650 B1) in view of Lion (US 6,330,491 B1), in view of Engelson et al. (US 6,671,563 B1), and further in view of Edelson et al. (5,737,539).

(A) Claims 3-8, 22, and 28 have not been amended and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

7. Claims 89 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (US 6,421,650 B1) in view of Simcox (5,992,890), and further in view of Engelson et al. (US 6,671,563 B1).

(A) Claims 89 and 91 have not been amended and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

***Response to Arguments***

8. Applicant's arguments filed 6/9/08 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 6/9/08.

(1) Applicant argues that Engelson does not teach the prescriber providing a reason overriding a drug use evaluation due to a discrepancy occurring during the act of prescribing. Engelson is directed towards administration of tracking in a hospital, not the decisions underlying the prescribing of medication.

(A) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the *prescriber* providing a reason....") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Engelson is directed towards administration tracking in a hospital, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The Examiner respectfully submits that Engelson was relied upon to teach the limitation of entering a reason for overriding an alert. As

such, the collective teachings of Goetz, Lion, and Engelson address the limitations of claim 1.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571) 272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. N./  
Examiner, Art Unit 3626  
In  
7/23/08

/C Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626